

REMARKS

Claims 1-22 remain pending, claims 21 and 22 are currently amended. No claims are canceled or added.

Applicant notes the comments in the Office Action regarding the Information Disclosure Statements (IDSs). To provide a complete record, applicant files concurrently with the present submission a Supplemental IDS, which includes all intended references. Note that U.S. Patent No. 6,342,568 was originally listed inadvertently. Instead, U.S. Patent No. 6,243,568 was intended. Both references are listed now. Acknowledgement and consideration of the listed references is now requested.

Claims 21 and 22 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Regarding claim 21, applicant amends the claim as shown above. Regarding claim 22, applicant respectfully disagrees that a slash ("/") renders the claim unclear. However, to expedite prosecution, applicant amends claim 22 as shown above. The amendment also includes changes to address matters of form. Withdrawal of the indefiniteness rejection is now requested.

Claims 1, 2, and 22 stand rejected under 35 U.S.C. § 103(a) as obvious over Hori et al., U.S. Patent No. 5,276,714. Applicant respectfully traverses this rejection as improper.

Regarding claims 1 and 2, base claim 1 describes a "digital broadcasting receiver" that has a "detector" and a "receiving condition reporting means." Claim 2 depends from claim 1, so claim 2 also describes this subject matter.

The Office Action indicates that any one of the following three Hori et al. elements is a "detector": (1) broadcasting/non-broadcasting determination circuit 38; (2) frame synchronization protection circuit 39; and (3) frame synchronization detection circuit 34. Fig. 5 shows that each of these elements is part of a MUSE sound decoder. However, to reject claims 1

and 2, Hori et al. still needs to teach or suggest the “receiving condition reporting means” of the claimed digital broadcasting receiver. Base claim 1 describes this element as follows:

a receiving condition reporting means for reporting by at least one of video and audio that the receiving condition is degraded in a stage where the degradation of the receiving condition of the broadcasting wave has not exceeded an error correctable range.

According to the Office Action, it would have been obvious to modify the Hori et al. circuits 39, 39, and 34 to have receiving condition reporting means as claimed. Applicant respectfully disagrees.

The only reason provided in the Office Action for deeming the modification obvious is that a person skilled in the art:

would know by using, for example, a display to display the error correction range in a detector circuit in order to determine whether the broadcasting signal meet a certain criterion in the broadcasting wave.

However, an obviousness rejection cannot be supported by stating that one skilled in the art would understand that a particular modification would have been an improvement of the Hori et al. circuits. Instead, to justify an obviousness rejection, an Office Action must provide an explanation of why someone would have thought of such a modification *beforehand* instead of merely appreciating, after learning of the modification, that there would have been an improvement. The mere statement that the modified circuitry would have had a benefit cannot justify the rejection without a corresponding explanation of why someone skilled in the art, when reading the Hori et al. disclosure, would supposedly have thought of achieving that benefit by adding the missing “means for reporting.”

Regarding claim 22, the rejection relies in part on broadcasting/non-broadcasting determination circuit 38 to teach both the “first path” and the “second path” recited in the claim.

However, according to column 6, lines 41-53, circuit 38 detects a broadcasting/non-broadcasting identification flag in a digitized MUSE signal. The state of the flag indicates whether the MUSE signal is broadcast or non-broadcast from reproduction equipment. Circuit 38 indicates the flag setting to frame synchronization protection circuit 39.¹

The Office Action does not indicate how circuit 38 supposedly has one path for introducing “a report signal representing a degradation of a receiving condition of a broadcasting wave to a video display/audio output unit” and another path for introducing “said report signal to a video recorder.” (Applicant of course acknowledges the citation of text from columns 3 and 4, but this text does not discuss circuit 38.) As shown above, circuit 38 only indicates whether a MUSE signal is broadcast or non-broadcast from reproduction equipment. There is no report signal representing degradation as claimed. Furthermore, circuit 38 has only one input, but claim 22 recites *two* paths.

The Office Action acknowledges, at the bottom of page 4, the lack of an adequate Hori et al. teaching regarding a “report signal” as recited in claim 22. Accordingly, the rejection relies on the same rationale provided with respect to claim 1 to deem that claim obvious. Applicant explains above why that such rationale is not sufficient to justify an obviousness rejection.

Additionally, with respect to claim 22, the Office Action indicates that one skilled in the art would know that displaying certain conditions would indicate “which path has the broadcasting wave and which path does not have the broadcasting wave.” (Office Action, page 5, top.) However, circuit 38 of Hori et al. presumably operates properly as disclosed.² Therefore, there is no apparent reason why someone skilled in the art would want to modify the circuit to provide the additional information regarding which path has a broadcasting wave.

¹ Although reference number “38” is recited in column 6, line 53, it is clear from context that reference number “39” was intended instead for the frame synchronization protection circuit.

² Under 35 U.S.C. § 282, a patent is presumed valid.

Because the Office Action does not provide such a reason (and it did not even identify a first and second path), a proper explanation of why such modification would have been obvious has not been provided. Accordingly, the rejection of claim 22 has not been justified.

In view of the explanation above, applicant now requests the withdrawal of the obviousness rejection.

The Office Action indicates that claims 3-20 would be allowable if claims 3, 5, and 6 are rewritten in independent form. However, those claims depend from base claim 1, and applicant explains above why claim 1 should also be deemed allowable. Thus, it is not necessary to rewrite claims 3, 5, and 6, to obtain allowance of claims 3-20.

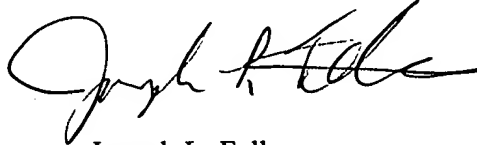
The Office Action also indicates that claim 21 would be allowable if rewritten to overcome the indefiniteness rejection. As discussed above, the indefiniteness rejection should now be withdrawn.

As a final matter, applicant amends page 7 to address an informality.

In view of the remarks above, applicant submits that the entire application is in condition for allowance, and a Notice of Allowability is now requested. If the Examiner believes that issues remain unresolved, he is welcome to contact the undersigned.

If necessary, the undersigned authorizes deducting any fees that may be due from Deposit Account No. 50-2866.

Respectfully submitted,
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read "Joseph L. Felber". The signature is fluid and cursive, with the first name "Joseph" being more prominent.

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Enclosure: Supplemental IDS

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